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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/855,440	05/15/2001	Hirotaka Uchiyama	8084	9009

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EXAMINER	
JONES, DWAYNE C	

ART UNIT	PAPER NUMBER
1614	

DATE MAILED: 09/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/855,440	UCHIYAMA ET AL.	
	Examiner	Art Unit	
	Dwayne C Jones	1614	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on *the amendment of 18JUN2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-52* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-52* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Status of Claims

1. Claims 1-52 are pending.

2. Claims 1-52 are rejected.

Response to Arguments

3. Applicants' arguments filed June 18, 2004 have been fully considered but they are not persuasive. Applicants argue the following points. Applicants argue that hindsight was used to reject the instant claims. Next, applicants purport that one of ordinary skill in the art would have the motivation to combine these prior art disclosures, especially as the technologies cited against the present invention are in various technical fields. Third, applicants' next argue that Trinh et al. only disclose of a composition of a CD and a surfactant, while the instant invention teaches of a composition comprised of a CD, a CD compatible surfactant, and a CD incompatible surfactant.

4. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA

1971). In particular, Wilson et al. teach of a composition, which contains cyclodextrin along with an anionic surfactant. Laughlin et al. teach of compositions, which contain ethoxylated zwitterionic surfactants and anionic surfactants and even cationic surfactants, while Bailey et al. teach of quaternary ammonium surfactants and Bailey et al. disclose of organosilicon surfactants. Accordingly, the instant composition claims are rendered obvious over the prior art references of Wilson et al. in view of Laughlin et al. of U.S. Patent No. 3,959,461 in view of Bailey et al. of U.S. Patent No. 3,929,678 in view of Bailey et al. of U.S. Patent No. 3,299,112.

5. In response to applicant's argument that Wilson et al. in view of Laughlin et al. of U.S. Patent No. 3,959,461 in view of Bailey et al. of U.S. Patent No. 3,929,678 in view of Bailey et al. of U.S. Patent No. 3,299,112 is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). Because the instant claims are composition claims, the argument that there are various technologies in various fields with the prior art references is found unpersuasive. For these reasons, the current rejection of Wilson et al. in view of Laughlin et al. of U.S. Patent No. 3,959,461 in view of Bailey et al. of U.S. Patent No. 3,929,678 in view of Bailey et al. of U.S. Patent No. 3,299,112 clearly teaches the skilled artisan of a composition that contains the very same components that are instantly claimed.

6. Third, applicants' argue that Trinh et al. only disclose of a composition of a CD and a surfactant, while the instant invention teaches of a composition comprised of a CD, a CD compatible surfactant, and a CD incompatible surfactant. The prior art reference of Trinh et al. teaches of a composition that is comprised of a CD with a surfactant. Trinh et al. additionally teach that the surfactant can be cationic, nonionic, amphoteric, zwitterionic, anionic polymeric, and even cationic polymeric, (see claims 1, 10, 11, and 13-15). Because the instant invention as well as Trinh et al. provide the examples of a CD compatible surfactant as tetronic surfactants and a CD incompatible surfactant as amphoteric surfactants and anionic surfactants, (see column 12 of Trinh et al.), the rejection of claims 1-52 over Trinh et al. is maintained. In addition, the instant claims are open-ended. Applicant recites the word "comprising", which is open-claim language. It is held that "the word 'comprising' incorporates additional steps of procedures and does not exclude materials or processes not recited in the claim". *Gould v. Mossinghoff, Comr. Pats.*, (DCCD 1982) 215 USPQ 310. Moreover, the skilled artisan is provided with explicit teachings of Trinh et al. that suitable surfactants with the cyclodextrin compounds are selected from nonionic surfactants, cationic surfactants, amphoteric surfactants, zwitterionic surfactants, and mixtures thereof, (as listed in claim 13). Here, the skilled artisan is provided with the teaching that these above-mentioned surfactants are suitable for combining with the cyclodextrin in a composition, which renders the instant invention obvious over Trinh et al.

Claim Rejections - 35 USC § 103

7. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

8. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

9. The rejection of claims 1-52 under 35 U.S.C. 103(a) as being unpatentable over Wilson et al. in view of Laughlin et al. of U.S. Patent No. 3,959,461 in view of Bailey et al. of U.S. Patent No. 3,929,678 in view of Bailey et al. of U.S. Patent No. 3,299,112 is maintained and repeated for the above-stated and reasons of record. Wilson et al. teach of the well-known property that cyclodextrins demonstrate a remarkable complexation behavior with a wide variety of inorganic and organic inclusates, (see page 927). In addition, Wilson et al. teach of binding constants between the inclusates and the cyclodextrin. In fact, Wilson et al. further teach of binding constants between beta-cyclodextrin and fluorocarbon as well as anionic surfactants, (see pages 927 and 928). Bailey et al. teach of the quaternary ammonium surfactants, (see abstract and entire patent). Laughlin et al. teach of detergent compositions that contain ethoxylated

zwitterionic surfactants and anionic surfactants and even cationic surfactants, (see entire patent). Bailey et al. teach of the surfactants of organosilicon, (see columns 1 and 2). Wilson et al. teach of a composition, which contains cyclodextrin along with an anionic surfactant. Laughlin et al. teach of compositions, which contain ethoxylated zwitterionic surfactants and anionic surfactants and even cationic surfactants, while Bailey et al. teach of quaternary ammonium surfactants and Bailey et al. disclose of organosilicon surfactants. Due to the fact that it is well known that cyclodextrins are used to encapsulate inclusates and because Wilson et al. do teach of a composition which contains beta-cyclodextrin and fluorocarbon as well as anionic surfactants, (see pages 927 and 928), it would have been well within the purview of the skilled artisan to include other surfactants in a composition which contains cyclodextrin. The skilled artisan would have been motivated to include other surfactants as an optimization in a cyclodextrin composition, especially when Wilson et al. teach of a composition between a beta-cyclodextrin and fluorocarbon as well as anionic surfactants, (see pages 927 and 928). In addition, the skilled artisan would have been motivated manufacture this CD composition because it is well known in the art that CDs are known in the art to encapsulate hydrophobic moieties. It is well within the level of the skilled artisan to use CDs to deliver hydrophobic substances as well as encapsulating hydrophobic moieties acting as a hydrophobic moiety scavenger.

10. Furthermore, applicants' claims recite the word "comprising", which is open-claim language. It is held "the word 'comprising" incorporates additional steps of procedures and does not exclude materials or processes not recited in the claim." see *Gould v.*

Mossinghoff, Comr. Pats., (DCDC 1982) 215 USPQ 310. For these reasons, Woo et al. does render the instant claims under the judicially created doctrine of obviousness-type double patenting as being unpatentable.

Obviousness-type Double Patenting

11. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

12. The rejection of claims 1-52 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-21 of U.S. Patent No. 5,578,563 is maintained and repeated. Although the conflicting claims are not identical, they are not patentably distinct from each other because Trinh et al. do teach of a composition comprising CD with a surfactant. Trinh et al. further state that the surfactant can be a surfactant that is cationic, nonionic, amphoteric, zwitterionic, anionic polymeric, cationic polymeric, (see claims 1, 10, 11, and 13-15). Moreover, the skilled artisan is provided with explicit teachings of Trinh et al. that suitable surfactants with the cyclodextrin compounds are selected from nonionic surfactants, cationic surfactants,

amphoteric surfactants, zwitterionic surfactants, and mixtures thereof, (as listed in claim 13). Here, the skilled artisan is provided with the teaching that these above-mentioned surfactants are suitable for combining with the cyclodextrin in a composition, which renders the instant invention obvious over Trinh et al.

13. The rejection of claims 1-52 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-17 of Woo et al. of U.S. Patent No. 6,436,442 is withdrawn in response to the Terminal Disclaimer of June 29, 2004.

14. The rejection of claims 1-52 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-59 of copending Application No. 09/855,816 is maintained and repeated. Although the conflicting claims are not identical, they are not patentably distinct from each other because methods of manufacturing CD composition along with a CD compatible surfactants and CD incompatible surfactants as well as compositions with these above-stated components.

15. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Conclusion

16. **THIS ACTION IS MADE FINAL.** Applicants are reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to D. C. Jones whose telephone number is (571) 272-0578. The examiner can normally be reached on Mondays, Tuesdays, Thursday, and Fridays from 8:30 am to 6:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Low, may be reached at (571) 272-0951. The official fax No. for correspondence is (703) 872-9306.

Also, please note that U.S. patents and U.S. patent application publications are no longer supplied with Office actions. Accordingly, the cited U.S. patents and patent application publications are available for download via the Office's PAIR, see http://pair-direct.uspto.gov. As an alternate source, all U.S. patents and patent application publications are available on the USPTO web site (www.uspto.gov), from the Office of Public Records and from commercial sources.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications may be obtained from Private PAIR only. For more information about PAIR system, see http://pair-direct.uspto.gov Should you have any questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 1-866-217-9197 (toll free).

DWAYNE JONES
PRIMARY EXAMINER

Tech. Ctr. 1614
September 1, 2004